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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,085	12/28/2001	Yonas D. Seme	41826888US	3973
45979 7590 05/05/2010 PERKINS COIE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER JACKSON, JAKIEDA R				
ART UNIT 2626		PAPER NUMBER		
NOTIFICATION DATE 05/05/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

### Office Action Summary

**Application No.**

10/035,085

**Applicant(s)**

SEME, YONAS D.

**Examiner**

JAKIEDA R. JACKSON

**Art Unit**

2626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-42 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-42 and 48-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the Office Action mailed October 30, 2009, applicant submitted an amendment filed on January 28, 2010, in which the applicant amended and requested reconsideration.

### ***Response to Arguments***

2. Applicants have amended the claims to cancel the rejected claims leaving the claims that were thought to be allowed pending, however, the indicated allowability of claims 37-42 and 48-52 are withdrawn in view of the newly discovered reference to Christy et al. Rejections based on the newly cited reference follow. The Office regrets any inconvenience.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 37-38, 42 and 48-49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christy et al. (PGPUB 2002/0002452), hereinafter referenced as Christy in view of Stringham (PGPUB 2002/0188670).

Regarding **claims 37 and 48**, Christy discloses a method and system for translating instant messages exchanged during an instant messaging session between a first user (sender) using a first device (client computer: figure 5, element 510<sub>1</sub>) and a second (recipient) user using a second device over a communication network (client computer: figure 5, element 510<sub>2</sub>), the first user having a first translation preference (French) and the second user having a second translation preference (Chinese: paragraph 0071), the method comprising:

Two servers, each implement both conversion and translation capabilities so that any user may be a sender or recipient. The user is capable of sending a message to the other user, in the usual fashion, and in his native language and *before transmitting the message to the recipient*, the sender interacts with his server, disambiguates and places the message in conformity.

According to Christy the recipient's device, rather than the sender's device, translates the information into the appropriate language, and, Christy's system and method does not specifically teach the exchange of the language preference or the translation at the sender's device.

Stringham, in the same field of endeavor, teaches that language translation may be performed at the sender's device (abstract). Stringham requires the system to be knowledgeable of the recipient's language preference. The language preference is sent to the first device (sender's device) and thus it would be obvious for the second user to exchange the language preference prior to a message being sent (the same

goes for the transaction with the second user receiving the first user's language preference).

The Examiner invokes KSR, wherein it would have been obvious to try, choosing from a finite number of identified, predictable solutions with a reasonable expectation of success, to change the translation location to the first device of Stringham from the second device of Christy (prior to any message being received from the users), which allows for the systems to be able to communicate with one another by being knowledgeable of the users' language preferences, before a message is sent, such that the message recipient does not need to translate incoming messages or enlist the services of a person with language translation skills. Also, transmission error concealment would be simpler for a message that is already translated, rather than having to combine error concealment with language translation at the recipient's location. Thus, a person of ordinary skill has a good reason to pursue the known options (as described above) within the technical grasp, which leads to anticipated success.

Regarding **claims 38 and 49**, it is interpreted and rejected for similar reasons as set forth in claims 37 and 48.

Regarding **claim 42**, Christy discloses computer-readable medium instructions for performing the steps recited in claim 37 (medium; paragraphs 0041-0043).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 39-41 and 50-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Christy in view of Stringham and in further view of Chin et al. (PGPUB 2001/0029455), hereinafter referenced as Chin.

Regarding **claims 39 and 50**, Christy in view of Stringham disclose a method for translating instant messages, but does not specifically teach wherein the translation preference is specified as a destination language.

Chin discloses the method and system wherein the translation preference is specified as a destination language (location/country of origin; paragraph 0261), to obtain higher translation quality.

Therefore, it would have been obvious to one of ordinary skill of the art at the time the invention was made to modify Christy in view of Stringham's method as described above, to allow for the input language to be as clean and proper as possible for the translation engine (paragraph 0137), as taught by Chin.

Regarding **claims 40 and 51**, Christy in view of Stringham discloses a method for translating instant messages, but does not specifically teach wherein the translation preference is specified as a locality.

Chin discloses an instant messaging method and system wherein the translation preference is specified as a locality (location; paragraph 0261), to obtain higher translation quality.

Therefore, it would have been obvious to one of ordinary skill of the art at the time the invention was made to modify Christy in view of Stringham's method as described above, to allow for the input language to be as clean and proper as possible for the translation engine (paragraph 0137), as taught by Chin.

Regarding **claims 41 and 52**, Christy in view of Stringham discloses a method for translating instant messages, but does not specifically teach wherein the translation preference is specified as a geographic setting.

Chin discloses the method and system wherein the translation preference is specified as a geographic setting (location/origin; paragraph 0261), to obtain higher translation quality.

Therefore, it would have been obvious to one of ordinary skill of the art at the time the invention was made to modify Christy in view of Stringham's method as described above, to allow for the input language to be as clean and proper as possible for the translation engine (paragraph 0137), as taught by Chin.

**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAKIEDA R. JACKSON whose telephone number is (571)272-7619. The examiner can normally be reached on Monday-Friday from 5:30am-2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jakieda R Jackson/  
Examiner, Art Unit 2626  
April 13, 2010

/Talivaldis Ivars Smits/  
Primary Examiner, Art Unit 2626

4/30/2010